IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: James Allen Clark et al.

Confirmation No.   4571

Serial No.:   09/864,360   Examiner: Annan Q. Shang

Filed: May 23, 2001   Group Art Unit: 2623

For: CONTENT DISCOVERY AND DIFFERENTIAL ADVERTISING IN VIDEO DISTRIBUTION NETWORKS

Date: September 27, 2007

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

This review is requested for the reason(s) states on the attached sheet(s). Note: no more than five (5) pages may be provided.

I am the: ☒   attorney or agent of record

Total of (1) forms are submitted.

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.

Derek Meeker
Reg. No. 53,313

Customer No. 20575

MARGER JOHNSON & McCOLLOM
210 SW Morrison Street, Suite 400
Portland, OR 97204
(503) 222-3613

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ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF CONFERENCE

This request is being filed with a Notice of Appeal.

Status of the Claims

Claims 1-7, 9-12, 14-16, and 18-40 are pending.

Claims 1-7, 9-12, 14-16, and 18-40 are rejected.

Seidman does not teach the transmission of services available information either expressly or inherently.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *MPEP 2131 Anticipation.* "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. ... To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by

persons of ordinary skill." *MPEP 2112 Requirements of Rejection Based on Inherency; Burden of Proof.*

Thus, for a rejection under 35 U.S.C. §102, each and every element must be either expressly taught or if not, must be necessarily present in the reference. That an element *may* be present is insufficient. As described below, the following elements of the claims 1, 9, 15, 18, 22, 25, 26, 30, and 31 are not expressly taught or necessarily present in Seidman.

Claim 1 includes a module operable to "detect services available information, the services available information indicating an availability of services at the network termination unit, and transmit the services available information in the use pattern packets." Thus, information in the availability of services at the NTU is transmitted. Claim 22 includes similar elements. Claim 15 includes similar tracking of service available information.

The Examiner is apparently not making a distinction between user selections and services available information indicating the availability of services. Seidman expressly teaches transmission of selection history. However, it is not necessary that a selection of a user inherently includes services available information. For example, a user may select a service that is available and also select a service that is not available. That the user has made a selection does not inherently indicate the selected service is available or unavailable. See the Amendment dated August 17, 2006, p. 9, line 9 to p. 10, line 13. Thus, the transmission of user selections and other history in Seidman does not teach each and every element of claims 1, 15, and 22.

Claim 26 includes a content analyzer with "a means for receiving use pattern packets from a network termination unit; and a processor to monitor the data for services available information, the services available information indicating an availability of services at the network termination unit." Thus, claim 26 describes a content analyzer that receives the services available information from the NTU. As described above, Seidman does not teach the tracking or other collection of services available information at an NTU, let along the transmission of it. Accordingly, it does not monitoring the data from an NTU for services available information.

Claim 18 includes tracking video content delivery. Claims 25 and 31 include similar elements. Although Seidman describes tracking a user's viewing history, viewing history as used in Seidman and video content delivery are distinct. Tracking of viewing history in Seidman is described only by monitoring a user's selections. Thus, what is tracked is a user's interaction with the STB to make a selection. Nothing is mentioned concerning the delivery of

video content to a viewing device. Although content is delivered to an NTU in Seidman, and the content may be customized using a user's viewing history, tracking that a user made a selection does not mean that the delivery of the content was tracked. It is not necessary to track delivery of video content in order to generate a user's viewing history. As a result, Seidman does not teach each and every element of claims 18, 25, and 31. See Amendment dated August 17, 2006, p. 13, line 9 to p. 14, line 2.

Furthermore, claim 18 specifically recites tracking video content delivery to the viewing device. The selection of a user has no bearing on the delivery of the video content to the viewing device. That a user selected video content does not even mean that the video content was delivered. For example, a user may select video content, and then the viewing device may receive the video content. Alternatively, the video content may be already delivered to and stored on the viewing device before the user selects it. Thus, the selection by a user does not necessarily teach tracking of video content to a viewing device. As a result, Seidman does not teach each and every element of claim 18.

No suggestion or motivation to combine Seidman and Teich.

The Examiner has failed to make a prima facie case of obviousness regarding claims 32-39. "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." *MPEP 2143 Basic Requirements of a Prima Facie Case of Obviousness.*

The Examiner argued that "it would have been obvious to one of ordinary skill in the art to incorporate the teaching of Teich into the system of Seidman in order to process error free packets or valid packets and provide an effieiency system and furthermore to notify the source of packets or contents which have been received to enable the source or service provide to acknowledge receipt of its services." Office Action dated April 4, 2007, p. 9-10.

In contrast to the Examiner's reason to combine the references, Teich explicitly teaches against using the disclosed error checking for multimedia data. Teich gives examples of error tolerant, invulnerable data as digital audio data and video data. Teich, col. 3, ll. 28-34. For

invulnerable data, a flag is set to a second state. Teieh, col. 3, ll. 37-40. As can be seen in FIG. 1 of Teich, if the flag is in the second state in 112, processing continues in 114 without the error detecting in 118 or correcting in 122. In other words, for multimedia data, such as audio or video data, the corresponding packets are not checked for errors.

The selection of particular packets that are not checked for errors is the focus of the improvement in Teich. Teich recognizes that checking each data frame is a time consuming and network congestion-inducing task. Teich, col. 2, ll. 20-22. By only performing the error checking on vulnerable frames, transmission of data is sped up, less congestion occurs, and robust (or invulnerable) frames are allowed to have errors. Teich, col. 4, ll. 6-14.

One skilled in the art would not combine the digital multimedia system of Seidman with the error correction for multimedia data in Teich since Teich explicitly teaches against it.

No teaching or suggestion of all claim limitations

Even if Seidman and Teich are combined, the combination of Seidman and Teich does not teach or suggest all of the limitations of claims 34-35, and 38-39.

Claim 38 includes a module operable to determine if data of a monitored content signal that should have been received at a point in time was received. Claim 34 includes a similar element within a content analyzer. Teich operates on packets or frames individually. Teich, col. 4, ll. 17-22, and FIG. 1. It does not disclose any relationship between packets or frames. In addition, Seidman does not disclose any relationship of packets that should have been received by a point in time. Merely checking a received packet for errors, optionally correcting errors, and optionally requesting retransmission of an errored packet does not teach or suggest any time relationship to other packets. As a result, there is no monitoring, tracking, or otherwise determining if data that should have been received was received. Therefore, the combination of Seidman and Teich does not teach or suggest each and every element of claims 34 or 38.

Claim 39 includes a module operable to verify a complete delivery of an advertisement. Claim 35 includes a similar element implemented in a content analyzer. As described above, there is no relationship between packets and frames suggested in Seidman and Teich. Since an advertisement will likely include more than one frame or packet, the lack of a relationship shows that the combination of Teich and Seidman does not teach or suggest verifying a complete delivery of an advertisement.

However, even if an advertisement includes only one packet or frame, combination of Teich and Seidman does not suggest verifying that it is complete. Even if a single packet or single frame is checked for errors, that checking for errors is not suggestion to verify that the single packet or the single frame was a complete advertisement. Such a determination deals with the content of the packet or frame. Error checking does not deal with the content of the packet or frame. In contrast, error checking deals with the integrity of the data forming the content. As a result, the combination of Teich and Seidman does not teach or suggest each and every element of claims 35 and 39.

With respect to claims 32-39 the Examiner failed to make a prima facie ease for obviousness either by failing to provide a reason to combine Seidman and Teich or by failing to teach or suggest each and every element.

Conclusion

The Applicant also asserts all arguments made previously, whether or not explicitly discussed herein, to preserve the right to assert these arguments in the Appeal Brief.

Customer No. 20575

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.

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